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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/351,399	07/13/1999	AKIRA OGINO	450100-4982	9658

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EXAMINER

REAGAN, JAMES A

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/351,399

Applicant(s)

OGINO ET AL.

Examiner

James A. Reagan

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 13-15, 20-24, 32-36, 44-46 and 51-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 13-15, 20-24, 32-36, 44-46 and 51-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in response to the amendment received on 16 December 2002.
2. Claims 1-3, 13, 20, 32-34, 44, and 51 have been amended (paper #13).
3. Claims 1-5, 13-15, 20-24, 32-36, 44-46, and 51-55 have been examined.
4. The Examiner respectfully reminds the Applicant to cancel all non-elected claims.

RESPONSE TO ARGUMENTS

5. Applicant's arguments received on 16 December 2002 have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.
6. With regard to the limitations of claim 1, Applicant argues that the passages cited by the Examiner do not specifically disclose *an output means for supplying the information on copyright protection encrypted by the encryption means and the*

unencrypted information on copyright protection. Examiner disagrees, however, and points to the Applicant's own reason in the arguments. As stated by the Applicant, "Schneck discloses an encrypted body part and unencrypted body part." It would be obvious to one of ordinary skill in the art at the time of the claimed invention to modify Schneck to include copyright protection information in both the encrypted and unencrypted parts. Naturally, if parts of the body can be encrypted or left unencrypted, it would be equally uncomplicated to encrypt only parts of the copyright information.

Previous Claim Objections

7. Claims 1-5 and 32-36 were objected to because of minor following informalities. The Examiner would like to thank the Applicant for correcting the minor informalities within the claims. The objection to claims 1-5 and 32-36 is hereby withdrawn.

Previous Claim Rejections - 35 USC § 112

8. Claims 1-5, 13-15, and 44-46 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner would like to thank the Applicant for correcting the deficiencies within the claims. The objection to claims 1-5, 13-15, and 44-46 is hereby withdrawn.

9. The following is a **Final Rejection** of all claims and associated limitations pending in the current application as amended in paper #7.

Examiner's note: Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the *entire* reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 4, 5, 23, 24, 35, 36, 54, and 55 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification, as originally filed, does not provide support for the invention as is now claimed, i.e., the system having "a watermark detecting

means for detecting the copy control information from said main signal" and "additional-information detecting means for detecting said additional information..." (See claims 4, 5, 23, and 24). More specifically, the specification, as originally filed, does disclose "a watermark detecting means" and "additional-information detecting means" are the same element rather than two separate elements as is now claimed in the rejected claims. Likewise, the specification, as originally filed, does not provide support for the invention as is now claimed, i.e., the system having "detect copy control information from said main information signal" and "additional information fro controlling a copy operation has been added to said main information signal..." (See claims 35, 36, 54, and 55).

Although Applicant states that independent claims 1, 20, 32, and 51 have been amended to overcome this rejection, it appears that claims 4, 5, 23, 24, 35, 36, 54, and 55 have not been amended.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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13. Claims 1-5, 13-15, 20-24, 32-36, 44-46, and 51-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-65662 (JP `662 hereinafter) in view of Schneck et al. (Schneck hereinafter: US PAT. 6,314,409 B2) and Ryan et al. (Ryan hereinafter: US PAT. 6,374,036 B1).

Claims 1, 13, and 20:

JP `662 discloses an information signal playback system having all of the features claimed except for the explicit disclosure of (a) the output means for supplying the information on copyright protection encrypted by the encryption means and the unencrypted information on copyright protection and the main information signal on which copy control information is embodied to the information signal processing apparatus and (b) a watermark detecting means: see an attached figure. However, Schneck discloses the output means for supplying the information on copyright protection encrypted by the encryption means and the unencrypted information on copyright protection and the main information signal on which copy control information is embodied to the information signal processing apparatus and copy control information for a system to control access and distribution of digital property (e.g., Abstract; col. 7, lines 22-50; col. 10, lines 47-65; col. 13, lines 58-62; col. 23, lines 25-27). Further, Ryan discloses the use of watermark for controlling copy of a digital video signal. Thus, it would have been within the level of ordinary skill in the art to modify the system of JP `662 by adopting the teachings of Schneck and Ryan

to enhance the functions of the claimed system by providing additional copy protection features.

Claims 32, 44, and 51:

None of JP `662, Schneck and Ryan explicitly discloses the claimed methods. However, it would have been obvious to operate the system which would have been obvious as stated supra.

Claims 2,14, 21, 33, 45, and 52:

Both Schneck (e.g., col. 18, lines 11-17) and Ryan (e.g., col. 2, lines 30-35) disclose that the information on copyright protection is media-type information indicating the type of the recording medium. Thus, it would have been within the level of ordinary skill in the art to modify the apparatus and method of JP `662 by adopting the teachings of Schneck and Ryan to provide better control of reproduction of the information to the claimed apparatus and method.

Claims 3, 15, 22, 34, 46, and 53:

JP `662 does not explicitly disclose the use of CSS system. However, CSS system is one of old and well-known recording and reproducing system and nothing unobvious is seen to have been involved simply having employed this well known system for an information signal playback system of the sort here involved.

Claims 4, 5, 23, 24, 35, 36, 54, and 55: 1, 13, and 20:

None of JP `662, Schneck and Ryan explicitly disclose the use of additional information (additional digital watermark information). However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to any desirable number of digital watermark information, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to **James A. Reagan** whose telephone number is **(703) 306-9131**. The examiner can normally be reached on Monday-Friday, 9:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **James Trammell** can be reached at (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231


or faxed to:

(703) 305-7687	[Official communications; including After Final communications labeled "Box AF"]
(703) 308-1396	[Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

JAR

25 January 2003


JAMES P. TRAMMELL
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